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N.G.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/328,877

06/09/99

GURNEY

M

6142.N2-CP

EXAMINER

HM22/0614

PHARMACIA & UPJOHN COMPANY
GLOBAL INTELLECTUAL PROPERTY
301 HENRIETTA STREET
KALAMAZOO MI 49001

TURNER, S

ART UNIT

PAPER NUMBER

1647

DATE MAILED:

06/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/328,877

Applicant(s)
Gurney et al.

Examiner
Sharon L. Turner, Ph.D.

Art Unit
1647



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 3-23-01

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-41 is/are pending in the application

4a) Of the above, claim(s) _____ is/are withdrawn from consideration

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims 1-41 are subject to restriction and/or election requirements

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. Upon further review, the previous Restriction is hereby vacated. A new Restriction Requirement is as set forth herein.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I-VIII. Claims 1-23 and 34-38, drawn respectively to polynucleotides encoding SEQ ID Nos: 3, 4, 5, 6, 7, 8, 9 and 10 classified in class 536, subclass 23.1.
 - IX-XVI. Claims 24-32, drawn respectively to polypeptides of SEQ ID Nos:3, 4, 5, 6, 7, 8, 9 and 10 classified in class 530, subclass 350.
 - XVII-XXIV. Claim 33, drawn respectively to antibodies that bind specifically to polypeptides of SEQ ID Nos:3, 4, 5, 6, 7, 8, 9 and 10, classified in class 530, subclass 387.1.
 - XXV-XXXIV. Claims 39-41, drawn to a method of identifying an agent using respectively cell lines expressing the nucleic acid molecules encoding SEQ ID Nos:3, 4, 5, 6, 7, 8, 9, 10, and the cell lines of 6myc-N-sel10/2 and 6myc-N-sel10/6, classified in class 436, subclass 518.
3. The inventions are distinct, each from the other because of the following reasons:
4. Groups I-XXIV are related as products. The products are different and patentably distinct each from the other as they are comprised of different structural and functional features including different nucleic acids, amino acids, heavy and light chains and are differentially capable of hybridization, acting as an immunogens, specific binding and directing immune responses.

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5. Inventions I-VIII and XXV-XXXIV are related as products and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the cell lines can be practiced with Alzheimer's brain tissue and the cell lines can be used in the process of producing alternative fusion polypeptides via transfection of nucleic acid vectors.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. Because these inventions are distinct for the reasons given above and the search required for each of the groups is not required for any other group, restriction for examination purposes as indicated is proper.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

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amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

10. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to, Sharon L. Turner, Ph.D. whose telephone number is (703) 308-0056. The examiner can normally be reached on Monday-Thursday from 7:30-6:00 P.M.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (703) 308-4623.

Sharon L. Turner, Ph.D.
June 12, 2001

CHRISTINE J. SAOUD
PRIMARY EXAMINER

Christine J. Saoud